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HAROLD B. WILLEY, Clerk

IN THE

Supreme Court of the United States

OCTOBER TERM, 1954.

No. 748

MALL TOOL COMPANY,

Petitioner,

vs.

BORG-WARNER CORPORATION,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

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PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

Petitioner prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Seventh Circuit, entered in the above-entitled case on November 17, 1954.

CITATIONS TO OPINIONS BELOW.

The memorandum opinion of the district court (R. 313-328) is reported in 120 F. Supp. 514. The opinion of the Court of Appeals (App., pp. 1-12) is reported in 217 F. 2d 850. The petition for rehearing was denied without opinion (App., p. 13). The opinion of the Court of Appeals denying the motion to reopen judgment (App., pp. 15-20) is as yet unreported.

JURISDICTION.

The judgment of the Court of Appeals for the Seventh Circuit was entered on November 17, 1954 (Cert. R.). Rehearing was denied on January 18, 1955 (Cert. R.; App., p. 13). The time for filing a petition for a writ of certiorari was extended to June 17, 1955, by order dated March 30, 1955 (App., p. 14). A motion to reopen judgment was denied by order dated April 6, 1955 (Cert. R.). The jurisdiction of this Court is invoked under 28 U.S.C., Section 1254 (1).

QUESTIONS PRESENTED.

1. Does the doctrine that the claim measures the grant and determines its validity still impose limits on the doctrine of equivalency?

A. Can a patent claim be valid which describes nothing more than an old device in the same art, even though the old device functions in a different way than the device disclosed in the patent specification?

B. Does a finding by the Court that an old device in the same art functions in a different manner from the device described in the patent specification relieve the Court of the necessity of examining each claim of the patent which it upholds, to see if the claim actually defines anything different from the old device?

C. Has the doctrine that the claim measures the grant become so devitalized that a patent can now be upheld on the basis of an invention derived from the specification despite the fact that such invention is not defined by the particular claims held valid and infringed?

D. Can patent claims be valid which have been construed so broadly as to cover the mere use of an old kind of saw tooth on a different type of saw where the

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saw tooth in the new use performs the same cutting functions it had always performed?

2. Does a deliberate course of conduct by a patent applicant, short of restricting claims by amendment, which shows a definite intention to accept a monopoly with a specific limitation, estop the applicant from ignoring this same limitation in asserting that a device infringes because it is a mechanical equivalent of the patented device?

3. Can a court hold that infringement exists solely on the basis of equivalency where the accused device completely omits one of the elements of the patentee's combination, no element being substituted for the omitted element and the remaining elements being unchanged; and where the patentee taught the public that the omitted element was essential to the invention?

4. Is evidence of the inherent operation of an old device inadmissible to prove anticipation merely because the old device is disclosed in the drawings of a patent issued by a foreign country?

STATUTES INVOLVED.

"The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."

(35 U. S. C., Section 112, second paragraph; 66 Stat. 798.)

"A person shall be entitled to a patent unless—

* * * * *

"(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, * * *"

(35 U. S. C., Section 102, in part; 66 Stat. 797.)

STATEMENT.

A. The Case in Brief.

This litigation involves Hassler patent No. 2,326,854, which issued August 17, 1943 and is entitled "Method and Means for Sawing Wood", although relating mainly to chain saws (R. 344-353; App., pp. 49-58, Abst. Hassler Pat.). As can be seen in Figure 12 of the patent drawing, Hassler's chain saw was made up of pairs of blade-like side cutting teeth, each pair followed by pairs of L-shaped bottom cutting teeth and a drag tooth. All of the teeth are supported on pivotally-connected links. In operation the side walls of the saw groove or kerf are defined by the side cutting teeth, while the kerf bottom is formed by the lateral toe portions of the L-shaped teeth. The vertical shanks of the L-shaped teeth follow in the path of the side cutting teeth, but do no cutting themselves (App., p. 53). The drag teeth carry the severed sawdust or wood chips through and out of the kerf.

The Hassler patent contains eighteen claims, which break down generally into two groups. The first group, including Claims 1 and 2, is directed to a chain saw in which certain links provide slicing elements having transverse bottom routing edges, such as those found on the toe portions of Hassler's L-shaped teeth, and other links provide side cutters having cutting edges lying at the marginal edges of the saw chain, such as the cutting edges on Hassler's blade-like teeth. The other group, including Claims 9, 10, 13, and 14, relates specifically to L-shaped saw teeth (App., pp. 56-58).

The Borg-Warner Corporation, owner by assignment of the Hassler patent brought suit under 28 U. S. C., Section 1338(a), in the United States District Court for the Northern District of Illinois, Eastern Division, against

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the Mall Tool Company. After a non-jury trial before the Honorable John P. Barnes, a judgment was entered September 24, 1953, which held in substance that defendant's commercial chain saws did not infringe any valid claims of the patent. Specifically, the trial court held the saw teeth Claims 9, 10, 13 and 14 invalid, and the chain saw combination Claims 1 and 2, as well as Claims 11 and 12, valid if limited to a chain saw having separate side and bottom cutting teeth, and therefore infringed only by models which defendant had manufactured in limited numbers but never sold (R. 336, 335, 28-29). Defendant's commercial chain saws which were held non-infringing are typified by its Square Chisel Chain and its Side Planer Chain, which contain only L-shaped cutting teeth (App., pp. 61, 62).

Plaintiff appealed the adverse judgment (except as to claims 11 and 12) to the United States Court of Appeals for the Seventh Circuit, pursuant to 28 U. S. C., Section 1292(4) (R. 337). Defendant did not cross appeal. By opinion dated November 17, 1954, the Court af Appeals affirmed the holding that Claims 9, 10, 13 and 14 were invalid, but reversed the holding below that Claims 1 and 2 could not be construed to cover defendant's commercial chain saws without making these claims invalid (App., pp. 1-12).

A petition for rehearing was filed December 2, 1954, which the Court of Appeals considered on four briefs (App. pp. 21-48), and denied by order dated January 18, 1955 (App., p. 13). On February 16, 1955, defendant filed a motion to reopen based on newly discovered evidence. This motion was heard on briefs, affidavits, and exhibits, and denied by opinion dated April 6, 1955 (App., pp. 15-20).

B. Detailed Statement.

1.

A chain saw is a machine used principally for commercial lumbering. It includes an endless flexible chain made up of links riveted together and carrying a series of cutting elements or saw teeth. It also includes an engine to drive the saw chain, and a guide bar around which the chain travels. Chain saws of this general construction have been known for many years (App., pp. 63, 64; R. 412-417, 450-452). The general sawing art is of course even older.

Both the trial judge and the Court of Appeals found that L-shaped saw teeth, covered by Claims 9, 10, 13 and 14 of the patent, were known long before Hassler (App., pp. 9-12), and for this reason held these claims invalid. The trial judge also refused to construe Claims 1 and 2 to cover anything more than Hassler's specific combination of cutting elements which included the separate side cutters, because in his view the enlarged claims would lack invention (R. 326). If broadly construed, among other things, Claims 1 and 2 would cover the mere substitution of an old type of saw tooth on a different variety of saw, which the trial judge thought did not rise to the dignity of invention. The Court of Appeals disagreed, holding that Claims 1 and 2 could validly cover chain saws, like defendant's commercial products, which use only L-shaped cutting teeth (App., pp. 6-8). This result was apparently based mainly on the finding:

> "* * * that the essential novel feature contributed by Hassler in his chain saw combination was an L-shaped tooth having both its shank and lower horizontal edge sharpened so as to cut off and under the wood fibers, respectively, leaving the debris behind to be pulled away by a drag element following the tooth, thus preventing clogging, which had been so troublesome in earlier devices." (App., p. 3.)

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Defendant had previously contended and again urged in its Petition for Rehearing that Claims 1 and 2 are not expressly limited to L-shaped teeth, and that consequently their validity cannot be supported on the basis of a finding like that made by the Court of Appeals. On the other hand, defendant urged that Claims 1 and 2 *are* expressly limited to chain saws having separate side cutting teeth.

Claim 1, which can be taken as typical of both claims reads:

> "1. In a chain saw, a plurality of pivotally joined links, *certain of said links* having formed thereon angularly disposed slicing elements extending from one marginal edge of said chain saw towards the longitudinal center line of said chain saw, said slicing elements having transverse, bottom routing edges formed thereon, said slicing elements being arranged in pairs oppositely disposed and spaced laterally apart, and *others of said links* having formed thereon side cutters having cutting edges lying at the marginal edges of said chain saw." (R. 352; App., p. 56; italics added.)

Defendant pointed out to the Court that the "bottom routing edges" mentioned in Claims 1 and 2, might or might not be provided by L-shaped teeth, whereas other claims in the patent contain a precise designation of L-shaped teeth. (See App., pp. 56-58, Hassler Pat. Claims.) On the other point of construction, defendant stressed the specific recitation in Claims 1 and 2 that the bottom routing edges are formed on "certain of said links" while the side cutting edges are formed on "others of said links."

The Court of Appeals, however, adopted a broad construction of Claims 1 and 2, and held that infringement existed despite the fact that defendant's chain saws lacked separate side cutting teeth. At the same time, the Court treated Claims 1 and 2 as if they recited "L-shaped" teeth in order to save them from invalidity.

On the infringement issue, the Court quoted with approval plaintiff's contention that:

> "* * * since every tooth of the accused structures includes a slicing element and a side cutter, it follows, necessarily, that some of the teeth have slicing elements and others side cutters, and that, thus, the language as well as the spirit of the claims is satisfied in the accused structures." (App., p. 6.)

On the validity issue, the Court did not discuss the relationship of Claims 1 and 2 to the invention which it attributed to Hassler. Instead, the Court merely stated that:

> "* * * the defendant cannot escape infringement of Claims 1 and 2 by any of the exhibits submitted, for the reason that they are equivalents of what Hassler prescribed * * * [T]he language of each claim is broad enough to include the devices complained of and the latter employ, if not in exactly the same form, the underlying invention of Hassler." (App., p. 7.)

As a further reason why Claims 1 and 2 could not be valid if construed broadly, defendant repeatedly urged that a broad construction of these claims made them read literally on an earlier chain saw (App., p. 69, Shipe Pat. Drawing; App., p. 70, charts). Plaintiff never at any time pointed out any language in these claims distinguishing from the chain saw of the Shipe patent. The issue in plaintiff's view was whether the earlier chain saw was functionally equivalent to the one described in Hassler's patent. Plaintiff contended that if it was not, the doctrine of equivalency saved the claims from invalidity, despite the lack of language distinction (App., pp. 21-48).

The Court of Appeals regarded the Shipe chain saw as functionally non-equivalent to Hassler's chain saw (App., pp. 8-9). In denying the Petition for Rehearing, the Court of Appeals must have accepted plaintiff's legal doctrine

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that a patent claim need not distinguish a non-equivalent prior-art device. There is no evidence that the Court itself made any examination of Claims 1 and 2 to see if they actually defined anything different from Shipe's chain saw.

2.

In rejecting defendant's contention that Hassler had deliberately accepted a limited monopoly which if recognized would have precluded a holding of infringement, the Court of Appeals stated:

> "Despite any terminology employed by Hassler in presenting his case, an examination of his claims and specification indicate a sharp divergence from anything that Shipe taught." (App., p. 8.)

This willingness to overlook what Hassler said and did while obtaining his patent amounts to a reversion to the narrow estoppel rule announced in *Bassick Co.* v. *Faultless Caster Corp.*, 105 F. 2d 228, 231 (C. A. 7, 1939); following *Spalding & Bros.* v. *John Wanamaker*, 256 Fed. 530 (C. A. 2, 1919). These cases hold that an estoppel must be based on the restriction of broader claims by amendment. Other circuits hold that an estoppel may also arise from other conduct. *e.g.*, *Godfrey L. Cabot, Inc.* v. *J. M. Huber Corp.*, 127 F. 2d 805, 807 (C. A. 5, 1942).

The estoppel issue revolves around Hassler's deliberate use of the terms "certain" and "others" in Claims 1 and 2 to describe his arrangement of cutting edges in a chain saw and to distinguish this arrangement from that found in the old chain saw of Shipe (App., pp. 59-60). As has already been mentioned, Claims 1 and 2 recite that the bottom routing edges are formed on "*certain* of said links" while the side cutting edges are formed on "*others* of said links" (App., pp. 56, 57). These terms provide a definite language distinction from Shipe's chain saw, only if con-

strued as requiring that the side cutting edges are on separate links from the bottom cutting edges (App., p. 70).

Shipe's chain saw has side cutting edges and bottom cutting edges fully responding to the definition of Claims 1 and 2 except that both types of cutting edges are provided on the same links (App., p. 69), rather than the bottom cutting edges being on certain links and the side cutting edges on other links as in Hassler's arrangement (App., p. 59). When the terms "certain" and "others" are read to mean, *all links having both types of edges*, as was done by the Court of Appeals to bring defendant's commercial products within the claims, then the only language distinction from Shipe's chain saw is obliterated and these claims describe nothing more than an old device (App., p. 70).

Claims 1 and 2 were first presented during the prosecution of Hassler's patent application at a time when the Shipe patent was not before the Patent Examiner (App., pp. 59-60). Subsequently, Hassler himself called the Shipe patent to the attention of the Patent Examiner and made it a file wrapper reference, stating:

> "In order that the record may be complete as far as applicant is concerned, applicant calls attention to Shipe 323,602." (App., p. 59.)

At the same time Hassler pointed out, among other things:

> "Shipe 323,602 had the idea he could combine in a single element, slitting elements and routing elements * * *." (App., p. 60.)

In other words, Hassler was telling the Patent Examiner that his chain saw differed from Shipe's in that Shipe's had both the side cutting edges ("slitting elements") and the bottom cutting edges ("routing elements") combined into a single cutting element, as compared with his ar-

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rangement where the bottom cutting edges were on "certain" links and the side cutting edges on "other" links.

Hassler stressed in his patent the alternating or sequential cutting action which resulted from the separately spaced side and bottom cutting edges (App., pp. 50-53, italicized portions). He made a parallel representation directly to the Examiner before Claims 1 and 2 were allowed (App., p. 59). Moreover, the concept of a chain saw having both side cutting and bottom cutting edges on the same links is completely absent from Hassler's specification.

The Court of Appeals dismissed all this as "terminology employed by Hassler in presenting his case," and then construed Claims 1 and 2 broadly with respect to the critical terms "certain" and "others". Thus, the factual elements of estoppel were ignored.

3.

The nub of the case for the Court of Appeals was the finding that defendant's commercial chain saws functioned similarly to Hassler's chain saw (App., pp. 4-5, 7). The trial court also accepted this finding, but reached a decision on this issue of infringement contrary to the decision by the Court of Appeals,

> "* * * because no separate side cutting teeth, devoid of laterally extending toes, are embodied in Plaintiff's Exhibits 1, 2, 3, 4 or 5, they do not infringe claims 1 and 2." (R. 326.)

After referring to the above quotation, the Court of Appeals stated:

> "In reaching this conclusion we think the Court was misled into the belief that though the same result was accomplished by defendant, the elimination of one component prevented defendant's devices from

being the equivalents of Hassler's. Our language, in *Sears Roebuck & Co.* v. *Delta Mfg. Co.*, 78 F. 2d 745 (C. A. 7) is pertinent: * * * 'One does not escape infringement by providing a single element which fully responds to a plurality of elements in the patent.' (Citing cases.) To the same effect is *Apex Electrical Mfg. Co.* v. *Maytag Co. et al.*, 122 F. 2d 182 (C. A. 7). In *Graver Mfg. Co.* v. *Linde Co.*, 339 U. S. 605, at 608, the Court quoted with approval from an earlier case as follows: 'if two devices do the same work in substantially the same way, and accomplish the same result, they are the same, even though they differ in name, form, or shape.'" (App., pp. 5-6.)

On this issue, the essential facts are brought out by comparing defendant's Square Chisel chain (App., p. 61), for example, with Hassler's chain (App., p. 49). The Square Chisel chain contains only L-shaped cutting teeth and is completely devoid of separate side cutters. Further, the L-shaped teeth on the Square Chisel chain have the same configuration as Hassler's bottom cutting teeth. Thus, it is apparent that a chain saw substantially identical to defendant's Square Chisel chain can be produced by cancelling off the side cutting teeth on Hassler's chain, as indicated on the marked copy of Hassler's Fig. 12 (App., p. 49).

As already discussed, there is not the slightest suggestion in Hassler's patent specification that the separate side cutting teeth could be completely omitted. Instead, Hassler repeatedly emphasized the importance of first defining the kerf's side walls with the separate side cutting teeth and then cutting the bottom wall (App., pp. 50-53). In Claims 1 and 2 he defined the side cutters and bottom cutters as separate elements. The Court of Appeals, however, construed these claims as covering what would remain of Hassler's chain saw after all side cutters were removed.

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4.

Defendant's motion to reopen was based on certain foreign patents of Serin, consisting principally of his British Patent No. 176,363 of 1922 and the three additions to his French Patent No. 532,069 (App., pp. 67, 68). This motion was denied on the ground that allegedly anticipating foreign patents are in a radically different category from prior American patents (App., pp. 15-20). In so holding, the Court relied on *Carson* v. *American Smelting and Refining Co.*, 4 F. 2d 463, 465 (C. A. 9, 1925).

The *Carson* case was interpreted by the Court of Appeals as forbidding any elaboration or clarification of foreign patent drawings by way of demonstrations or expert testimony. Summarizing this view, the Court stated:

> "We must conclude either that defendant reads into these illustrations [certain figures of the British and French Serin patents] a broader concept than that which the patentee envisioned, or that the illustrations disclose a teaching broader than the claims and written specifications of the patent to which they are attached. Either alternative is fatal to defendant's position. *Carson* v. *American Smelting & Refining Co., supra.*" (App., p. 20.)

In its original opinion, the Court of Appeals stressed the broad novelty in Hassler's chain saw of the flow of chips over the bottom cutting edges and back beneath the links of the chain (App., pp. 2-3). This mode of operation was distinguished from that of Shipe's chain saw which "forced the debris directly through the links and out of the device." (App., pp. 8-9.) The Serin patents not only contain illustrations of chain saws which would operate like Shipe's but also contain other chain saw illustrations which defendant contended would inherently operate like Hassler's chain saw (App., pp. 67, 68). Defendant offered to prove its contention by the demonstra-

tion of working models and expert testimony with respect to the models, and asked that the case be reopened to permit this explanatory evidence to be introduced. The Court stated that the rule of the *Carson* case did not permit the introduction of evidence to show that foreign patent drawings disclose something that is not expressly stated in the patent itself.

A motion to reopen on the ground of newly discovered evidence involves a question of diligence. Defendant therefore submitted an affidavit to demonstrate its diligence, and also filed a formal offer to compensate plaintiff for injuries due to any lack of diligence with which it was properly chargeable (App., p. 16).

The Court of Appeals expressly declined to rule on the diligence issue, and the Court did not decide whether defendant's formal offer would cure a lack of diligence if it existed. The Court relied solely on its interpretation of the law relating to foreign patents as the basis for denying the motion to reopen (App., pp. 16, 20).

REASONS FOR GRANTING THE WRIT.

A. Summary.

1.

This case involves a novel question of fundamental importance to the administration of the patent system by both the federal courts and the United States Patent Office. The question is basically whether the doctrine of equivalency defined by this Court as a guide in determining infringement in *Graver Tank and Mfg. Co.* v. *Linde Air Products Co.*, 339 U. S. 605 (1950) is to be extended to eliminate the rule that the scope of patent protection should be measured by the patent claims, as restated in *Graver Tank and Mfg. Co.* v. *Linde Air Products Co.*, 336 U. S. 271, 277 (1949).

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The Court of Appeals relied on the doctrine of equivalency to the exclusion of the latter rule. It dismissed the old chain saw of Shipe solely on the basis that it was functionally non-equivalent to Hassler's chain saw in spite of the evident fact that Claims 1 and 2 as broadly construed described Shipe's old device in all particulars and were therefore invalid. No finding was made that Claims 1 and 2 are distinguished in any way from Shipe's device.

The rule that the claims must define the invention in clear structural terms and thereby distinguish it from the prior art has been a basic axiom of the United States patent system. *Grant* v. *Walter*, 148 U. S. 547 (1893); *Altoona Publix Theatres* v. *American Tri-Ergon*, 294 U. S. 477, 487 (1935); *Graver Tank and Mfg. Co.* v. *Linde Air Products Co.*, 336 U. S. 271, 277 (1949); 35 U. S. C., Section 112, second paragraph. This rule is the principal basis of the Examining procedure in the Patent Office. See *Manual of Patent Examining Procedure* (2d. Ed. 1953), Sections 608.01 (o), 706.02, 707.07 (d), 714.02, 904.01, etc. Claims cannot be allowed by the Patent Office even though the patent application discloses inventive subject matter unless the claim definition itself describes something more than the prior art. *In re Thuau*, 135 F. 2d 344 (C. C. P. A., 1943).

If a court were free to uphold the validity of a claim which fails to make any distinction between the subject matter of the patent and a prior art device, patent claims would become completely superfluous, as would the lengthy claim examining and amending procedure in the Patent Office. The claim would no longer measure the grant as required by *Graver Tank and Mfg. Co.* v. *Linde Air Products Co.*, 336 U. S. 271, 277 (1949); nor would the claim inform the public of the exact metes and bounds of the granted monopoly. See *United Carbon Co.* v. *Binney and Smith Co.*, 317 U. S. 228, 236 (1942); *General Electric* v.

Wabash Appliance, 304 U. S. 364, 369 (1938). The conclusion is inescapable that the Court of Appeals has exceeded its authority to the detriment of the patent system and the public interest.

2.

The decision of the Court of Appeals on the issue of infringement in this case constitutes a radical departure from Supreme Court law which has been well settled for nearly a century. The Court of Appeals in this case concluded that infringement can be found on a theory of mechanical equivalency even though one element of the patentee's combination is *completely omitted* without the actual substitution of any equivalent element. This ruling is directly contrary to *McClain* v. *Ortmayer*, 141 U. S. 419 (1891), and *Rees* v. *Gould*, 82 U. S. 39 (1872). The vitality of *McClain* v. *Ortmayer* was recently reaffirmed in *Graver Tank and Mfg. Co.* v. *Linde Air Products Co.*, 336 U. S. 271 (1949). The Supreme Court should exercise its supervisory authority so that the doctrine of infringement by equivalents will continue to be confined within its proper and well accepted boundaries.

3.

This case presents an opportunity for the Supreme Court to clarify the law of estoppel in patent cases. The law of estoppel in the various circuits is confused and conflicting. The Second Circuit, for example, has consistently held that a patentee is not estopped from asserting a broadened construction of his claims for infringement purposes because the construction is inconsistent with statements and arguments that had been presented to the Patent Office. *Spalding and Bros.* v. *John Wanamaker*, 256 Fed. 530 (C. A. 2, 1919). The Seventh Circuit tends to follow the same rule, *Bassick* v. *Faultless Caster*

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Corp., 105 F. 2d 228, 231 (C. A. 7, 1919), although there have been some apparent departures, *Thomas* v. *Simmons Co.*, 126 F. 2d 743 (C. A. 7, 1942). The Fifth Circuit definitely accepts the broader rule that an estoppel can be based on statements alone without any restrictive amendment. *Godfrey L. Cabot, Inc.* v. *J. M. Huber Corp.*, 127 F. 2d 805, 807 (C. A. 5, 1942). Other circuits look to statements and arguments made to the Patent Office as evidence of the patentee's concept of his invention, and then construe the claims in accordance with the inventive concept thus determined. *Modern Products Supply Co.* v. *Drachenberg*, 152 F. 2d 203, 207 (C. A. 6, 1945); *Allen-Bradley Co.* v. *Erie Resistor Corp.*, 104 F. 2d 150, 151-152 (C. A. 3, 1939).

In *Exhibit Supply Co.* v. *Ace Patents Corp.*, 315 U. S. 126, 136 (1942), this Court held that the doctrine of equivalents could not be relied on to recapture subject matter which had been excluded from a claim by restrictive amendment. The Supreme Court, however, has not as yet ruled on the question of the effect to be given to statements made in the papers submitted to the Patent Office. This Court should act to resolve the conflicts in practices of the circuits.

4.

In denying the motion to reopen, the Court of Appeals based its decision on a legal doctrine which discriminates against foreign patents contrary to the applicable statute. The Court expressly held that a defendant in a patent suit is barred from relying on the inherent method of operation of a prior art device just because it is found in a foreign rather than a domestic patent, stating that it was following *Carson* v. *American Smelting and Refining Co.*, 4 F. 2d 463, 465 (C. A. 9, 1925). 35 U. S. C. 102 (b) does not permit such a distinction. Under this statutory

provision the anticipatory effect of United States and foreign patents are the same.

The doctrine of the *Carson* case is an anachronism in American patent law which should be eradicated. See *Dewey & Almy Chemical Co.* v. *Mimex Co.*, 124 F. 2d 986, 990 (C. A. 2, 1942), for comment by Judge Learned Hand. Instead, the decision below in this suit has carried the *Carson* case doctrine to unprecedented heights. The Supreme Court should end this non-statutory discrimination against foreign patents.

B. Discussion.

This case presents the ominous spectre of equivalency running rampant. Acting under a sweeping concept of equivalency as the primary if not the sole desideratum in a patent suit, the Court of Appeals held claims valid which read squarely on the prior art, overrode a clear estoppel against the broadened claim construction which it adopted, and then went on to hold infringement by structures which completely omitted an essential element of the patentee's combination. Conversely, the same Court denied defendant the opportunity to prove that a prior art device inherently functions in a manner equivalent to the patentee's device just because the prior art device was shown in a foreign patent.

Such an approach to the issues involved in patent suits certainly benefits the patent owner, but the benefits are awarded at the expense of the public. If equivalency is to be paramount and all else subsidiary or irrelevant, the public would rarely be able to determine from the face of a patent the exact monopoly area which it covers. The only reliable criteria of infringement would be prolonged and expensive litigation in the course of which the federal courts would have to assume the duties now performed

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by the Patent Office. See *Claude Neon Lights, Inc.* v. *E. Machlett & Sons,* 36 F. 2d 574, 575-576 (C. A. 2, 1929), for a discussion of this subject by Judge Learned Hand.

This is not to say that there should be no doctrine of infringement by equivalents and we are not suggesting that the holding on rehearing in the *Graver* case be reconsidered. *Graver Tank and Mfg. Co.* v. *Linde Air Products Co.,* 339 U. S. 605 (1950). Neither are we merely asking for a review of that portion of the first *Graver* opinion which reaffirmed the rule that the claim measures the grant. *Graver Tank and Mfg. Co.* v. *Linde Air Products Co.,* 336 U. S. 271, 277 (1949). Indeed the Court of Appeals in this suit felt constrained to follow the express decision of the first *Graver* case in holding claims 9, 10, 13, and 14 invalid.

Stated broadly, the questions presented by this petition all involve important aspects of the relationship between the doctrine of equivalency and the rule that the claim measures the grant, which were not dealt with in either of the *Graver* opinions. The present suit offers a unique opportunity for clarifying each of the basic questions raised by this petition, both individually and in relation to the general structure of patent law doctrines.

1.

For all its broad language, the majority opinion on rehearing in the *Graver* case was obviously not intended to make new law. The Supreme Court had reaffirmed the doctrine that the claim measures the grant in its first opinion in that case. Moreover, on rehearing the majority expressly assumed the conclusive validity of the claims in issue. 339 U. S. at 607.

Thus, the *Graver* rehearing decision can give no comfort to those who would seek to use the doctrine of equiv-

alents to create the validity of a claim as well to test its infringement. This, however, is essentially what the Court of Appeals did in the present suit, and primarily on the basis of its view of the *Graver* rehearing decision. The validity of Hassler's Claims 1 and 2 as broadly construed was literally *created* by the dismissal of Shipe's chain saw as functionally non-equivalent, even though Shipe's device was fully described and not distinguished by the language of these claims.

It might be observed that the present decision by the Court of Appeals is a striking fulfillment of Justice Black's prediction in his dissenting opinion on the rehearing of the *Graver* case, where he objected particularly to the language of the majority opinion.

> "One need not be a prophet to suggest that today's rhapsody on the virtue of the 'doctrine of equivalents' will, in direct contravention of the Miller case (U. S.) supra, make enlargement of patent claims the 'rule' rather than the 'exception'."
>
> (*Graver Tank and Mfg. Co.* v. *Linde Air Products Co.*, 339 U. S. 605, 616 (1950), Justice Black dissenting.)

As brought out in petitioner's Statement, the construction of Hassler's Claims 1 and 2 which was adopted by the Court of Appeals in upholding these claims makes them fully and accurately descriptive of Shipe's old chain saw (App., p. 70). This construction is glaringly inconsistent with the established rule that the claims must measure the grant. *Grant* v. *Walter*, 148 U. S. 547 (1893); *Altoona Publix Theatres* v. *American Tri-Ergon*, 294 U. S. 477, 487 (1935); *Graver Tank and Mfg. Co.* v. *Linde Air Products*, 336 U. S. 271, 277 (1949).

The rule that the claim must measure the grant is based on statute as well as on the decisions of this Court. As stated in the Patent Act of 1952,

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"The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."

(35 U. S. C., Section 112, second paragraph.)

Clearly, the quoted statutory provision forbids sustaining patent claims which apply to the prior art as well as to the patentee's device. If Congress had intended that compliance with 35 U. S. C., Section 112 could be waived with respect to any category of prior art devices it would have so provided in the statute.

2.

The Court of Appeals held that defendant's commercial products did not avoid infringing Claims 1 and 2 even though these products completely omitted one element of Hassler's combination; namely, the separate side cutting teeth (App., pp. 5-7). The Court's decision on this point carried the doctrine of infringement by equivalents further than ever before. The two lower court cases relied on by the Court of Appeals do not on the facts support its position.

In *Sears, Roebuck & Co.* v. *Delta Mfg. Co.*, 78 F. 2d 745 (C. A. 7, 1935), the infringer actually substituted a new and different element from any which the patentee disclosed. Instead of the two separate clamps described by the patentee, the infringer used a specially-constructed clamping device which was adapted to perform the functions of both of the separate clamps in the patentee's structure. In the present case defendant has substituted nothing for any element described by Hassler. The separate side cutting teeth, which Hassler thought were essential to his combination, have been entirely omitted.

Neither does *Apex Electrical Mfg. Co.* v. *Maytag Co.*,

122 F. 2d 182 (C. A. 7, 1941), hold that infringement can be shown where an element of the patentee's combination has been omitted without the substitution of an equivalent element. In the *Apex* case one multi-purpose lever was actually substituted for the two levers described by the patentee.

In *Graver Tank and Mfg. Co.* v. *Linde Air Products Co.*, 339 U. S. 605 (1950), also cited by the Court of Appeals, a well known chemical equivalent (manganese silicate) was substituted for the alkaline earth metal silicates specified in the claims. In such situations there is a definite element of evasion—an equivalent is *substituted*—giving rise to something akin to practicing a fraud on a patent as stated in the majority opinion. When nothing is substituted, however, the equitable basis of the doctrine of equivalency is lacking. How can it amount to a fraud on a patent to simply omit something which the patentee taught was essential?

The Court of Appeals' holding on the issue of infringement herein is directly contrary to *McClain* v. *Ortmayer*, 141 U. S. 419 (1891), and *Rees* v. *Gould*, 82 U. S. 39 (1872). The correct rule on the present facts is well stated in *McClain* v. *Ortmayer* (recently reaffirmed in the first *Graver* opinion) where the infringer had completely omitted one of the two springs described by the patentee in combination with his horse collar.

> "While a single spring or hook embracing the fore wale of a collar may be equally as efficacious, the patentee is no more at liberty to say that the spring encircling the after wale is immaterial and useless than was the patentee in *Vance* v. *Campbell* to discard one of the elements of his combination upon the same ground."

Hassler now wishes to discard his separate side cutting teeth as immaterial and useless. This is forbidden by

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the legal doctrine of *McClain* v. *Ortmayer* and it has no equitable basis. If Hassler knew that his separate side cutting teeth were really unnecessary, he should have told the public this in his patent instead of proclaiming the contrary.

3.

What a patentee said and did during the process of obtaining his patent is a matter of public record. The complete file of any application which matures into a patent can be inspected on request at the Patent Office, or photostatic copies thereof can be obtained at a nominal charge. Further, most attorneys specializing in the practice of patent law regularly obtain and study these so-called file wrappers. The problem, however, is to what extent can the public and the patent bar rely on the content of a patent application file wrapper in determining whether the issued patent forecloses a proposed course of business activity.

The most serious problem relates to the legal effect of file wrapper statements, representations, and arguments by which a patentee disclaims certain broad constructions of his claims, without actually amending the claims themselves. Since the present suit involves such a factual situation, we commend its consideration by the Supreme Court as a means of harmonizing the law of "file wrapper estoppel" in the unsettled area beyond *Exhibit Supply Co.* v. *Ace Patents Corp.*, 315 U. S. 126, 136 (1942).

4.

We say that any distinction between the anticipatory effect of foreign and domestic prior art patents is expressly contrary to statute, notwithstanding the doctrine

of *Carson* v. *American Smelting and Refining Co.*, 4 F. 2d 463, 465 (C. A. 9, 1925). 35 U. S. C. 102 provides in part:

> "A person shall be entitled to a patent unless—
>
> • • • • •
>
> "(b) the invention was patented or described in a printed publication *in this or a foreign country* * * * more than one year prior to the date of the application for patent in the United States * * *." (Italics added.)

This statutory provision precludes treating foreign patents or publications any differently from domestic patents or publications. Indeed, in the usual course of events foreign patents become publications which are available domestically.

The result reached by the Court of Appeals on the motion to reopen is not even supported by the *Carson* doctrine as previously applied.

In the *Carson* case, evidence about the operation of the prior devices described in the foreign patents was actually received and considered, although it was given little weight because based on *ex parte* tests, 4 F. 2d at 465-466. This contrasts sharply with the refusal by the Court of Appeals to give the present defendant the opportunity to make *inter partes* courtroom demonstrations for the purpose of establishing that certain of Serin's chain saws function in a manner equivalent to Hassler's.

If the Court's extension of the *Carson* doctrine is to be the law it should apply to plaintiffs and defendants alike. It is doubtful if the Seventh Circuit would so apply it, in view of *Donner* v. *Walgreen Co.*, 44 F. 2d 637, 640 (N. D. Ill., 1930). Judge Lindley, the author of the opinion being reviewed, then a district judge, there permitted experimental evidence to be introduced by a plaintiff to show what was *not* inherent in the disclosure of a foreign

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patent. In fact, he held that the foreign patent failed to anticipate on the basis of the evidence about inherent results.

We think such evidence should always be received in behalf of either party to a patent suit. It certainly should not be barred by a discriminatory rule against foreign patents which directly contravenes the applicable statute.

CONCLUSION.

For the foregoing reasons, this petition for a writ of certiorari should be granted.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1954.

No. 748

MALL TOOL COMPANY,
Petitioner,

vs.

BORG-WARNER CORPORATION,
Respondent.

PETITIONER'S REPLY BRIEF.

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MALL TOOL COMPANY,

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Respondent.

PETITIONER'S REPLY BRIEF.

INTRODUCTION.

Respondent's brief merely skirts the boundaries of the novel questions of fundamental import presented by this case. The important legal issues involved cannot be brushed aside or reduced to mere questions of fact. Respondent has failed to meet Petitioner's arguments on the grounds for granting certiorari, and instead has presented arguments which are irrelevant or which it knows are false.

Respondent has charged that Petitioner's 70-page appendix is "fragmentary". We are at a loss to understand what has been omitted in Petitioner's presentation. Respondent's brief does not set forth any additional facts,

nor has Respondent supplemented Petitioner's appendix or cited any additional portions of the record.

It is worthy of note that Respondent's brief does not contain a single reference to the first opinion in the *Graver* case (*Graver Tank & Mfg. Co.* v. *Linde Air Products Co.*, 336 U. S. 271). This is most unusual since the petition developed at length the grave and as yet unresolved problems arising out of the relationship between the first *Graver* opinion and the opinion on rehearing (*Graver Tank & Mfg. Co.* v. *Linde Air Products Co.*, 399 U. S. 605). Respondent apparently would like to have the doctrine of equivalency applied to the complete exclusion of the rule that the claim measures the grant, thus ignoring the first *Graver* opinion. As pointed out in the petition, this approach to the legal issues involved in patent suits would confer unwarranted benefits on the patent owner at the expense of the public.

The Second Graver Opinion Is Not Authority for Using the Doctrine of Equivalency to Confer Validity on Defective Patent Claims.

While Respondent has made a *pro forma* denial that Petitioner's first question is actually presented in this case, its arguments acknowledge that this question is presented and seek to justify the decision below by its interpretation of the second *Graver* opinion. As Respondent recognizes, the precise issue is whether the doctrine of equivalency as interpreted in the second *Graver* case can be used to confer validity on a patent claim despite "verbal correspondence" between that claim and the prior art. Such a reading of the second *Graver* opinion would require the Court to adopt Respondent's head-in-the-sand position with respect to the first *Graver* case.

The petition pointed out that the second *Graver* case

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did not involve a question of claim validity, since the claims at issue were conclusively presumed to be valid. The Court merely applied the doctrine of equivalency in the usual way as a test of infringement. Therefore, it is clear that the second *Graver* opinion could not have been intended to overrule the first opinion in that case, reaffirming the rule that the claim measures the grant. It follows from this rule that claims which read literally on a prior art structure are invalid for lack of novelty, and cannot be saved because the prior device was constructed differently or did not function in the same way as the device described in the patent. If Respondent's contention to the contrary was correct, the broad metallic silicate claims which were under consideration in the first *Graver* case should not have been held invalid because they read literally on inoperative embodiments. Obviously, an inoperative embodiment is the antithesis of a functional equivalent. Yet the Court invalidated the metallic silicate claims because they failed to properly measure the grant. We submit, therefore, that not only does the second *Graver* opinion fail to support Respondent's position, but that Respondent's notion about using the doctrine of equivalency as a test of claim validity is patently inconsistent with the holding in the first *Graver* case invalidating the claims which read on nonequivalent embodiments.

Respondent's brief mentions two phrases from Hassler's Claims 1 and 2, and jumps to the conclusion that these phrases do not apply to Shipe's chain saw. Respondent offers nothing to support these conclusions. The first phrase ("from one marginal edge of said chain saw towards the longitudinal centerline") was tentatively offered as a distinction in Respondent's reply to the petition for rehearing (App. 36). The Court of Appeals granted special permission to Petitioner to file a supplemental brief answering this new point (App. 42-45). Upon

receipt of Petitioner's brief, Respondent expressly abandoned any reliance upon a distinction based on this language (App. 46-48).

Respondent has never before alleged that the language of the second phrase ("arranged in pairs oppositely disposed and spaced laterally apart") provides any distinction from Shipe's chain saw. That this language could not do so is evident from an examination of the cutting elements on Shipe's chain saw (App. 69, 70). Each of Shipe's cutting elements provides a pair of horizontally-extending, bottom cutting edges which are spaced apart by the central, vertically-extending blade. The Shipe patent (contrary to Respondent's suggestion that there is a single bottom cutting edge on each link) expressly points out that the bottom cutting edges on each side of the central blade act separately to cut out two chips, one of the chips passing outwardly on each side of the central blade (R. 385, Column 2, lines 60-91). It is therefore obvious that the bottom cutting elements on the Shipe chain saw are "arranged in pairs oppositely disposed and spaced laterally apart."

Respondent has not answered Petitioner's contention that Claims 1 and 2 read squarely on the prior art. The fact that the prior art is non-equivalent, rather than rendering these claims valid, proves their invalidity. The second *Graver* opinion does not aid Respondent in establishing the validity of its claims.

Respondent has chosen to present no answer at all to the subsidiary questions 1-B and 1-C. These questions, however, are of considerable importance and cannot be overlooked. They emphasize the extent of the Court of Appeals' unprecedented departure from the rule that the claim measures the grant. As stated in the petition, it is evident from the opinion below that the Court of Appeals failed to find how Claims 1 and 2 could be broadly con-

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strued and still be distinct from the Shipe chain saw. The Court's opinion also fails to find how the language of Claims 1 and 2 relates to the invention which the Court attributed to Hassler.

In discussing question 1-D, and elsewhere in its brief, Respondent seeks to lead this Court to believe that the validity of Claims 1 and 2 as broadly construed is supported by concurrent findings of fact. Respondent knows that this is untrue and is deliberately trying to mislead the Court. The trial court expressly held that Claims 1 and 2 would be invalid if construed to cover chain saws devoid of separate side cutting teeth (R. 334, Conclusions 1 and 2).

Respondent also appears to find comfort in the fact that both the Patent Office and the trial court held Claims 1 and 2 valid over the Shipe patent. We are not contesting these rulings. They were based on the narrow construction of Claims 1 and 2 which was adopted by the trial court and urged by Hassler before the Patent Office as a distinction from the Shipe patent. The Court of Appeals, on the other hand, rejected this narrow construction and adopted the broad construction which the District Court specifically held would render the claims invalid.

The Courts of Appeals Are Clearly in Conflict on the Proper Scope of the Doctrine of File Wrapper Estoppel.

We were amazed to find Respondent flatly denying the existence of any conflict between the Courts of Appeals on the proper scope of the doctrine of file wrapper estoppel. The conflict of the decisions in the circuits is well known to patent attorneys, and is an ever present source of practical difficulty in counselling the public about the scope of patent claims.

The extreme divergence of views among the circuits has been judicially recognized. This conflict is well defined by Judge Kaufman in *Van Der Horst Corp.* v. *Chromium Corp.*, 98 F. Supp. 412, 420 (S. D. N. Y., 1951):

> "In considering the file wrappers the Court does have in mind the rule in this circuit that the arguments made by the applicant to the examiner cannot be considered in construing claims, though the file wrapper can be examined to determine the question of estoppel through rejected claims. *A. G. Spalding & Bros.* v. *John Wanamaker*, 2 Cir., 1919, 256 F. 530. There is substantial authority to the contrary, however, which permits the file wrapper and Patent Office proceedings to be resorted to in order to construe a patent or determine on what distinction over the prior art the applicant was asking to receive his patent. *E. g. Wiegand* v. *W. Bingham Co.*, 6 Cir., 1939, 106 F. 2d 546; *Texas Co.* v. *Anderson-Prichard Refining Corp.*, 10 Cir., 1941, 122 F. 2d 829; *Howe* v. *Atwood*, D. C. E. D. Mich., 1942, 47 Supp. 979.
>
> The Court of Appeals for this Circuit in the *Spalding* case disapproved of 'looking at preliminary negotiations in the interpretation of a formal document intended to be the final memorial of the parties' intentions.' 256 F. at page 534. However, if there exists doubt as to the scope of the 'final memorial,' what better evidence of the intent of the parties entering into the 'contract' (a patent having been said to be a contract), is there than the 'negotiations' leading up to the issuance of the patent?
>
> "Under the view *not* sanctioned by this Circuit the plaintiff would be 'estopped' on the basis of the Meyer affidavit from claiming infringement by the defendant, in view of the Court's finding that defendant's depressions are produced according to the Cleveland method. However, under the view still in effect in this Circuit plaintiff survives the 'estoppel' barrier.
>
> "Therefore it is my finding that defendant's product infringes upon plaintiff's patent claims (not claim 4) despite the patentee's own assertions in the applica-

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tion proceedings that defendant's product bore no similarity to the patentee's product."

Respondent has even questioned Petitioner's citation of *Spalding & Bros.* v. *John Wanamaker,* 256 Fed. 530, as the leading case on the Second Circuit rule. We agree that the statement of the rule in the *Wanamaker* case is technically *obiter dictum.* However, it is based upon a prior express holding in *Auto Pneumatic Action Co.* v. *Kindler & Collins,* 247 Fed. 323 (C. A. 2, 1917), and it is the case most frequently cited by the courts within the Second Circuit for this proposition. If Respondent merely seeks to suggest that the decision of the Seventh Circuit in the present suit is in agreement with the rule of the *Wanamaker* case, we certainly agree.

In our opinion, the line of cases with which the decision below conflicts is best exemplified by *Cabot, Inc.* v. *Huber Corp.,* 127 F. 2d 805 (C. A. 5, 1942). Respondent has attempted to reduce the holding of the *Cabot* case to a semblance of consistency with the rule that an estoppel can only be based on a restrictive amendment to patent claims. In the *Cabot* case, as in the present case, the only action taken by the patentee consisted of arguments during the prosecution of his application which reflected a a definite intention to adopt a specific limited meaning for certain claim terms.

Respondent would also have this Court believe that *Exhibit Supply Co.* v. *Ace Patents Corp.,* 315 U. S. 126, defines the outer limit of file wrapper estoppel. The question of the effect to be given to arguments presented to the Patent Office was not in issue in that case, and neither in the *Ace* case nor in any other has the Supreme Court indicated what the law should be with respect to estoppels based on conduct by a patent applicant other than restrictive amendment of his claims.

The Mere "Functional Presence" of an Omitted Element Does Not Constitute a "Substitution" to Which the Doctrine of Equivalency Can Be Applied.

Respondent pretends to see no departure from precedent in the decision reached by the Court of Appeals that Claims 1 and 2 can be infringed by structures which completely omit the separate side cutting teeth of Hassler's chain saw combination. In this regard, we direct attention to Walker on Patents, Sec. 461 (Deller's Ed. 1951):

> "Omission of one element or ingredient of a combination covered by any claim of a patent, averts any charge of infringement based on that claim. * * * And it makes no difference that another element is made to do the work of itself and of the omitted element [*Underwood Typewriter Co.* v. *Royal Typewriter Co.*, 224 Fed. 477 (1915)]. A combination is an entirety. If one of its elements is omitted, the thing claimed disappears. Every part of the combination claimed is conclusively presumed to be material to the combination, and no evidence to the contrary is admissible in any case of alleged infringement. [Citing *McClain* v. *Ortmayer*, 141 U. S. 419 (1891), and numerous other decisions] * * *."

Petitioner and Respondent agree that Hassler's side cutting teeth are not used by Petitioner, although the L-shaped teeth on Petitioner's saws perform both the side-cutting and bottom-cutting functions. Thus, while it possibly could be contended that Hassler's side-cutting teeth are in a sense "functionally present" on Petitioner's saws, this is not a sufficient basis for a finding of infringement. See Walker on Patents, *supra*. The omission of an element of a patentee's combination avoids infringement, and it makes no difference that one of the remaining elements is made to do the work of itself and of the omitted element.

Respondent concedes that the Court's construction of Claims 1 and 2 makes them cover the fragmentary de-

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vice which would be obtained by cancelling off all of the side cutting teeth of Hassler's chain. (See App. 49.) This is plainly not a case where an element has been substituted for an omitted element: Hassler's separate side cutting teeth have been completely omitted and the remaining L-shaped teeth have not been modified.

The heretofore well-settled legal distinction between a case like the present one, where an element has been completely omitted, and a case in which something has been substituted for an omitted element is based on substantial policy considerations. This Court has pointed out that the doctrine of equivalency is designed to prevent a fraud on a patent; it could equally well be said that the doctrine that complete omission of an element avoids infringement operates to prevent a fraud on the *public*.

It is plainly one of the paramount duties of a patentee to teach the public what is and what is not essential for practicing his invention. Where a patentee instructs the public that an element is essential to his combination (as Hassler did with regard to his separate side cutting teeth), the public is entitled to take the patentee at his word. Such an element "is conclusively presumed to be material to the combination, and no evidence to the contrary is admissible in any case of alleged infringement." Walker on Patents, *supra*.

The Discretion Vested in a Court Can Never Extend to the Application of an Erroneous Rule of Law.

Respondent has not directly answered Petitioner's fourth question.

The only record upon which Petitioner relies is the opinion of the Court of Appeals on the motion to reopen, and Petitioner bases its objection to this decision solely on the ground that the decision is based on an erroneous interpretation of the law.

Petitioner recognizes that motions to reopen are discretionary and subject only to a limited review. But where the Court has applied an erroneous principle of law as the basis for granting or denying a discretionary motion, it has not exercised its discretion. In such a case, the reviewing Court must remand the case for a proper exercise of discretion under the correct legal principles. *Fairmount Glass Works* v. *Cub Fork Coal Co.*, 287 U. S. 474, 482-484 (1933); *Mattox* v. *U. S.*, 146 U. S. 140 (1892); *Freid* v. *McGrath*, 133 F. 2d 350, 353 (C. A. D. C., 1942); *Youdan* v. *Majestic Hotel Management Corp.*, 125 F. 2d 15 (C. A. 7, 1942).

As discussed at length in the petition, the Court of Appeals based its denial of the motion to reopen exclusively on its fallacious interpretation and application of *Carson* v. *American Smelting & Refining Co.*, 4 F. 2d 463 (C. A. 9, 1925). The Court ruled that the *Carson* case barred any elaboration or clarification of foreign patent drawings by way of demonstrations or expert testimony (App. 20). Such discrimination against foreign patents is contrary to statute, and is not authorized even by the *Carson* case.

The petition for a writ of certiorari should be granted.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1954.

No. 748

MALL TOOL COMPANY,
Petitioner,

vs.

BORG-WARNER CORPORATION,
Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO THE PETITION FOR A WRIT OF CERTIORARI.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1954.

No. 748.

MALL TOOL COMPANY,

Petitioner,

vs.

BORG-WARNER CORPORATION,

Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO THE PETITION FOR A WRIT OF CERTIORARI.

OPINIONS BELOW.

Subsequent to the filing of the Petition herein, the latest opinion of the Court of Appeals for the Seventh Circuit in this case has been reported at 105 U. S. P. Q. 147.

STATEMENT OF THE CASE.

The Petition for Writ of Certiorari presents no grounds specified by Rule 19 for issuance of the writ. The questions sought to be presented are not in this case but have been contrived by Petitioner to lend a semblance of substance to the Petition.

This is an ordinary patent case, exceptional only in that the patent presents a revolutionary improvement in an old mechanical art. Petitioner's attempted distinction of

the infringing devices from the patent disclosure and claims is based only upon verbal and technical contentions that completely ignore the substance of the structures and patents involved.

The Court of Appeals Has Expressly Considered and Rejected All of Petitioner's Contentions.

The patent in suit is on a chain saw (R. 344-353). In his preferred embodiment, the patentee showed the saw chain having as its principal cutting elements a pair of opposed L-shaped teeth (router teeth) each suspended by its vertical shank and having a sharpened horizontal toe projecting from the side of the chain toward its middle. This horizontal toe sliced the chip from the bottom of the kerf, where it lay to be removed by a non-cutting depth gauge which was longitudinally spaced from the router tooth (Figs. 12, 15, R. 348). In his preferred embodiment the patentee showed the saw chain also carrying separate vertical side-cutter teeth to make the vertical cut at the side of the kerf (Fig. 14, R. 348). The infringing chain, here in issue, typified by Defendant's Exhibtis 1 and 4 (R. 303, 306) is distinguished merely in that it omits the separate side cutters (which had been used on some of the chains made by Petitioner) and shifts the work of these separate side-cutter teeth to the sharpened vertical shanks of the router teeth.

The commercial impact of the patented chain was well expressed by the District Court in its Findings 13-15 (R. 332), in which the Court reviewed the evidence of sales of the patented chains. The Court found that Petitioner's sales of prior-art non-infringing chains fell from 67% of its chain volume in 1950 to 30% in two years; in the same period its sales of infringing saw chains rose from 33% to 70%, and its sales of complete chain saws equipped with

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infringing chains to 93% of such sales (Finding 19; 333).

As the District Court found, the saw chain art went ck to 1885, but prior to the patentee Hassler no one had r employed a saw chain with teeth of the type to which patent in suit is directed (Finding 12; R. 331).

The District Court found the broad claims (9, 10, 13, 14) of the patent in suit invalid. After expressing ne uncertainty over the issue (R. 325-326), it construed ims 1 and 2—the only claims before this Court—as dis-sing invention and valid, only when limited to require separate side cutters as shown in the patentee's pre-red embodiment (R. 334). The District Court also found ims 1 and 2 infringed by saw chains made by Petitioner ich employed separate side-cutter teeth (Def. Ex. 5 and R. 307, 308), but refused to apply the doctrine of equiva-ts to structures in which the work of the side cutters s shifted to the sharpened vertical shanks of the router th (Def. Ex. 1 to 4, R. 303-306).

The Court of Appeals, accepting and endorsing the Find-gs of Fact, reversed this last ruling of the District Court. e Court of Appeals held that such a construction of this oneer patent violated the law as laid down by this Court *Graver* v. *Linde*, 339 U. S. 605, 607-609. It applied the strict Court's findings that the accused devices did ex-ly the same work as the patented chain saw in substan-lly the same manner, and were therefore the equivalents the patented structure. In this reasoning the Court of peals meticulously applied the law of the *Graver* case.

The Petition asks essentially for a review of the facts. is Court has repeatedly stated that routine review of facts is not the office of certiorari. *Keller* v. *Adams-mpbell & Company, Inc.* (1924), 264 U. S. 314, 319. While Petition speaks of imagined conflicts of decision and

alleged misapplication of the patent law, and prays for an opportunity to embellish the doctrines of equivalency and file wrapper estoppel with ingenious novelties, the record does not present the alleged issues which are advanced as invoking this review.

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ARGUMENT.

The "Questions Presented" By Petitioner Are Not in This Case.

The Petition in this cause sets forth four questions, the first having four subsidiary questions. It will be shown in this brief that none of these questions as framed by Petitioner is presented by this record; they are created merely by adroit use of a fragmentary appendix produced by interlineations and a cunning excision of relevant facts.

Petitioner's first question with four subordinate questions (Pet., p. 2), in effect attacks the Court of Appeals' holding that the Shipe patent (R. 384) does not anticipate Claims 1 and 2 of the patent in suit, and insinuates, contrary to Petitioner's own admissions, that the Court of Appeals ignored the patent claims in finding the infringing structures equivalent to the structure of those claims.

Question 1A. The Shipe patent of 1885 is practically the only patent which Petitioner relies on in this Petition. It formed the substance of Petitioner's case in the Court of Appeals, although Petitioner had relied on 27 patents on the trial.

The Shipe patent had been brought to the attention of the Patent Office by the patentee (Def. Ex. 9, p. 44). The Patent Office granted Claims 1 and 2 over that patent.

Considerable testimony was evoked in the District Court on the Shipe patent and the District Court held Claims 1 and 2 valid thereover. Petitioner's expert readily admitted the many structural and functional distinctions which existed between the Shipe disclosure and the saw chain covered by the Hassler patent (R. 242-6, 251, 266, 278). The most significant of the testimony is that of Petitioner's

expert that if the Shipe tooth were to be used on a modern chain saw it would unquestionably have to be redesigned (R. 244).

The Court of Appeals reviewed the disclosure of the Shipe patent at length (Pet. App., pp. 8-9), and while Petitioner says (Pet., p. 9),

> "There is no evidence that the Court itself made any examination of Claims 1 and 2 to see if they actually defined anything different from Shipe's chain saw."

and (Pet., p. 15),

> "No finding was made that Claims 1 and 2 are distinguished in any way from Shipe's device."

the Petition also quotes from the Court of Appeals' opinion that (Pet., p. 9),

> " 'Despite any terminology employed by Hassler in presenting his case, an *examination of his claims* and specification indicate a sharp divergence from anything that Shipe taught.' " (Emphasis supplied.)

The Court of Appeals' opinion (Pet. App., p. 2) quotes Claim 1 in full and states, as Petitioner does (Pet., p.7) that Claims 1 and 2 are for all essential purposes the same.

The most cursory examination of the Shipe structure discloses that it does not respond to Hassler's claims 1 and 2. This is wholly apart from the complete lack of correspondence in the structure and function of the Shipe and Hassler devices which this Court, in *Graver* v. *Linde*, 339 U. S. 605, 608-609, ruled would control over any mere verbal correspondence.

Both of the Hassler claims demand, among other things, that the slicing elements of the router teeth extend "from one marginal edge of said chain saw towards the longi-

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tundinal center-line" thereof, and that these slicing elements be "arranged in pairs oppositely disposed and spaced laterally apart".

Shipe has no such slicing elements. The Shipe teeth are suspended from a shank in the middle of the tooth and extend across the full width of the kerf. They are not arranged in pairs, are not oppositely disposed, and are not spaced laterally apart (R. 384).

In fact, the Shipe patent makes a virtue of the fact that the chain is composed of a series of identical teeth and says:

> "* * * each link of the chain is made to displace the whole chip, instead of depending upon succeeding links to do so, and to effect the ready clearance of the cut chips; * * * said bit or cutter of each link removing the chip the full width of the kerf, and thus doing away with the necessity of a series of cutters applied to each succeeding pair of links, as in a former invention of mine." (R. 385, Col. 1, lines 18-28).

There is no need here to review all of the structural and functional differences of the Shipe chain. It was designed to be drawn around a log and not to operate on a cutter bar of a chain saw. It forces the chips upwardly *through the chain*, as distinguished from the Hassler chain in which the chips are sliced from the bottom of the kerf and left there to be scavenged by a following non-cutting depth gauge. The Court of Appeals fully treated these significant and determinative considerations (Pet. App., pp. 8-9).

Questions 1B and 1C. The foregoing simple statement of what happened to Shipe in the Court of Appeals destroys any contention based upon Petitioner's asserted Questions 1B and 1C.

There is nothing in the Shipe patent that approaches Hassler or qualifies the range of equivalency accorded claims 1 and 2.

Question 1D. The question purportedly raised as Question 1D (Pet., p. 2) would have this Court review the Findings of Fact by the District Court, affirmed by the Court of Appeals, that the saw chain claimed in Hassler's claims 1 and 2 involves invention. Petitioner assails this conclusion on the ground that the combination was non-inventive. The Court of Appeals flatly ruled on this question (Pet. App. 7). The District Court pointed out that although the art of saw chains runs back to 1885, and the record contained at least sixteen patents on saw chains (R. 384, 392, 402, 412, 420, 424, 428, 432, 438, 442, 450, 458, 466, 482, 496, 517) in the intervening period, to the time of Hassler's invention no one had contrived the Hassler combination.

This Court will "not disturb the concurrent findings upon the issues presented * * * in the petition for certiorari." *Faulkner* v. *Gibbs,* 338 U. S. 267, 268.

Were the question of invention open on this record, the long history of saw chains all employing merely conventional saw tooth forms culminating in the revolutionary chain made by Hassler with its markedly impressive impact on the commercial art, would lead inevitably to the same conclusion that the Patent Office, the District Court, and the Court of Appeals reached.

Petitioner's Second "Question Presented" Attempts to Create a Question of File Wrapper Estoppel Where None Exists.

Petitioner states as its second "question presented" (Pet., p. 3):

> "2. Does a deliberate course of conduct by a patent applicant, short of restricting claims by amendment, which shows a definite intention to accept a monopoly with a specific limitation, estop the applicant from

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> ignoring this same limitation in asserting that a device infringes because it is a mechanical equivalent of the patented device?''

This Court has in a series of decisions unaltered in doctrine for seventy-five years, applied the principle of file wrapper estoppel. The doctrine has been most succinctly stated by the late Chief Justice Stone in *Exhibit Supply Co.* v. *Ace Patents Corp.*, 315 U. S. 126, 137. This doctrine dictates that a patentee who amends his patent claim to avoid a rejection by the Patent Office may not thereafter ask the courts to construe that claim with the same scope that it would have possessed had the amendment not been made; in other words, compliance with the ruling of the Patent Office to secure the patent operates as a disclaimer of the subject matter originally claimed, which may not thereafter be recaptured.

This is a wholesome doctrine, but it has no application in this case. The Court of Appeals expressly stated that

> ''* * * The trial court did not find any of the elements of estoppel in the evidence presented and we think, likewise, that the record does not sustain defendant's contention in this respect.'' (Pet. App. p. 9.)

Petitioner has, in its Appendix, set forth under the title ''Abstract of Hassler Patent File Wrapper'' (Pet. App., pp. 59-60) an adroitly emasculated version of the file wrapper and contents of the Hassler patent (Def. Ex. 9).

Where the actual exhibit contains two typewritten pages of a discussion of the distinctions between Shipe and Hassler, Petitioner quotes merely eight lines devoted to a single structural distinction. Petitioner ignores the remainder of the text which points out several other distinctions which conclusively differentiate Shipe and Hassler (Def. Ex. 9, pp. 44-46).

It is upon this single statement, presenting a completely

distorted picture of what occurred in the prosecution of the Hassler patent, that Petitioner would ask this Court to undertake a review of the doctrine of file wrapper estoppel.

At this period in the prosecution of the Hassler patent application Claims 1 and 2 were before the Patent Office, substantially as finally issued (later modified merely for clarity and not in substance; Def. Ex. 9, p. 36). The Shipe patent had never been cited against these claims, the claims had never been rejected as lacking invention, and the Patent Office never required or suggested any change of substance in these claims.

The Court of Appeals ruled directly on this issue (Pet. Ex. 9) and nothing is presented here that would challenge the conclusions of the Court of Appeals except by ignoring what actually occurred in the Patent Office.

The cases cited by Petitioner to create an asserted difference in the application of the doctrines of file wrapper estoppel by the Courts of Appeals of different circuits do not present any such situation.

In *Bassick Co.* v. *Faultless Caster Corp.*, 105 F. 2d 229, 231, the Seventh Circuit Court of Appeals merely held that it would not consider the patentee's argument to the Patent Office for the purpose of changing the plain wording of the patent claim, where the patentee argued that limitations in the claim be ignored to make the claim correspond to certain representations made in the argument to the Patent Office. The Court of Appeals said it had considered the argument made to the Patent Office to help determine the novelty disclosed in the patent, and to construe the claims in suit, but that when the novel feature was identified it was clear that the patent claims did not include this feature. This is the same treatment accorded Claims 9, 10, 13, and 14 of the Hassler patent by the Court of Appeals in this case.

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In *Spaulding & Bros.* v. *Wanamaker,* 256 Fed. 530, next cited by Petitioner, the Second Circuit dealt with the classical file wrapper estoppel situation. The patentee had sought broad claims in the Patent Office and after repeated rejection had narrowed these. Subsequently, in litigation to enforce the patent, the patentee sought to recapture by a construction of the patent claim, the scope which had been forfeited by the amendments made in the Patent Office to induce the issuance of the patent. Learned Hand, then District Judge said, merely in passing, that:

> "In the consideration of a file wrapper we do not look at the arguments of the applicant to the Examiner."

The statement was merely *obiter dictum.* Even had it been a specific ruling in the case, it would not conflict with anything done by the Seventh Circuit Court of Appeals in this case.

In *Modern Products Supply Co.* v. *Drachenberg,* 152 F. 2d 203, 207, the Sixth Circuit Court of Appeals did not employ statements made by the applicant to the Patent Office to modify the claims or in effect to permit such argument to constitute a file wrapper estoppel, but merely used those statements as significant evidence in determining whether or not there was structural identity in the substantial features of the accused machine and that covered by the patent claims. The Court gave to these arguments merely evidentiary weight in determining whether or not the differences between the accused and patented devices related to matters of substance or were merely formal differences.

There is no comparable problem in this case, where the Petitioner seeks to restrict the reading of the patent claim by reference to the patentee's discussion of prior art in the Patent Office, and the Court has independently found that that prior art has no functional or structural correspondence to the patented device.

In *Cabot, Inc.* v. *Huber Corp.*, 127 F. 2d 805, the Fifth Circuit Court of Appeals held that where the specification disclosed equipment and procedures which required turbulent agitation of the carbon being pelletized, the term "turbulent agitation", prominent in each claim, could not be satisfied by a procedure in which there was mere gentle pouring and shifting of the ingredients to form pellets. The Court referred not only to what was stated in the specification, but particularly to the fact that when the patent was before the Patent Office and the claims rejected upon a broad meaning of the term "turbulent agitation", the patentee induced the Board of Patent Appeals to reverse the action of the Examiner and rule that the patentee was entitled to a patent on a process involving "turbulent agitation". On the same basis the Commissioner of Patents, in an interference, ruled that the limitation to "turbulent agitation" distinguished from the method of the interfering patent and dissolved the patent interference. This is classical file wrapper estoppel, based not on what a patent applicant may have said in argument, but on action by the applicant which induced the Patent Office to alter its ruling, where the previous ruling was based on a misconstruction of the patent claim terms. No situation even approaching this is involved in the present case.

In *Allen Bradley Co.* v. *Erie Resistor Corp.*, 104 F. 2d 150, the Third Circuit Court of Appeals had before it a patent that contained claims to a procedure incorporating the step of calcining carbon black "at substantially graphitizing temperatures." The specification contained no specific data as to what graphitizing temperatures were, and the Court relied on both the independent evidence of witnesses that graphitizing temperature at the time the application was filed meant a temperature of about 2200°C. and the statements made by the applicant in the Patent Office that those temperatures were at least 1927°C. The

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argument before the Patent Office was relied upon as furnishing evidence of what the terms of the claim meant. The Court held that rather than hold the patent invalid for want of clarity of the patent claim terms, it would determine from other evidence what the terms as used in the patent were intended to mean.

There is no question of that kind in this case.

There is no case which carries the doctrine of file wrapper estoppel to the point to which Petitioner here would push it. There is no conflict between the decision on the issue of file wrapper estoppel in this case and the other decisions to which Petitioner refers.

Petitioner's Third "Question Presented" Is Based Upon the Contention That Petitioner's Infringing Saw Chains Omitted One Element of the Patented Combination, a Contention Rebutted By Admissions in the Petition.

The third question offered by Petitioner (Pet., p. 3) reads:

> "3. Can a court hold that infringement exists solely on the basis of equivalency where the accused device completely omits one of the elements of the patentee's combination, no element being substituted for the omitted element and the remaining elements being unchanged; and where the patentee taught the public that the omitted element was essential to the invention?"

The District Court in its Findings 8-10 (R. 328, 330, 331) found that the accused saw chains did exactly the same work as those of the Hassler patent and in the same way. The Court found specifically that the illustrations of the method of operation shown in Plaintiff's Exhibits 1c-4c (R. 295-298) accurately illustrated the manner in which the infringing saw chains operated. Those illustrations are practically identical, except for slight changes in struc-

ture, with the corresponding illustration in the Hassler patent (Fig. 12, R. 348).

As has been stated, the only difference between the two types of saw chains made by Petitioner is that in the types held to infringe by the District Court there are separate vertical side cutters, while in the types also held to infringe by the Court of Appeals the work of these side cutters has been shifted to the sharpened vertical shanks of the router teeth. No function has been omitted. No change in method or principle of operation has been effected.

In Petitioner's statement of the case, Petitioner describes the functions and operation of the respective side cutter and router teeth shown in the Hassler patent (Pet., p. 4):

> "* * * In operation the side walls of the saw groove or kerf are defined by the side cutting teeth, while the kerf bottom is formed by the lateral toe portions of the L-shaped teeth. The vertical shanks of the L-shaped teeth follow in the path of the side cutting teeth, *but do no cutting themselves.* * * *" (Emphasis supplied.)

Petitioner concedes that the infringing saw chains have no "side cutting teeth" but that the sharpened vertical shanks of the L-shaped teeth make the vertical cuts which, in the preferred embodiment of Hassler, were made by the side cutting teeth. This is incontrovertible. It was held both by the District Court and the Court of Appeals (Finding 10; R. 331; Pet. App., p. 6).

Thus Petitioner concedes that it has shifted the work of the separate side cutting teeth, omitted in the infringing saw chains, to the sharpened vertical shanks of the router teeth which, in the preferred embodiment of Hassler, Petitioner says "do no cutting themselves". There is thus a plain substitution. This shift in the cutting func-

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tion from a separate side cutter to the sharpened vertical shank of the router, particularly in view of the fact that Hassler's patent showed the form of router teeth which made this substitution possible, creates the clearest kind of equivalency.

Petitioner could not make the contentions presented under this alleged question if it had not shut its eyes completely to what this Court said of the law of equivalents in *Graver* v. *Linde*, 339 U. S. 605, 607-609, quoted on page 34 of Petitioner's Appendix.

All that Petitioner contends for is that this Court shall reverse itself and make the law of equivalents "the prisoner of a formula * * * and an absolute to be considered in a vacuum."

On this question Petitioner cites *McClain* v. *Ortmayer*, 141 U. S. 419, which is also cited in both of this Court's opinions in *Graver* v. *Linde*. In that case, the patent claim covered a sweat pad for a horse collar which had springs to grasp the front wales of the collar and separate springs independently to clasp the afterwales of the collar. The accused device had only a single spring hook made of wire which clasped the front roll of the collar, with no modification at all of the structure to provide means for accomplishing the function of the after-spring. There was thus both omission of a structural element and complete omission of its function. Obviously there was neither direct infringement of the claim, which specifically called for both sets of springs, nor was there any equivalency, as the accused structure had no provision for accomplishing the function of the after-springs. The accused device therefore could not accomplish the same result in substantially the same manner by substantially the same means.

Any attempt to evoke a conflict by comparing the rul-

ing in the present case with *McClain* v. *Ortmayer* must fail. Here no function of any element has been omitted. Here the sharpened vertical shanks of the router teeth, which in the preferred embodiment did no cutting, have been burdened with the entire work of making the vertical cut in the operation of the saw, as found both by the District Court and the Court of Appeals. In *McClain* v. *Ortmayer, one entire element was omitted with complete omission of its function.* There is no conflict between these two cases.

The able statement by Judge Learned Hand in *Claude Neon Lights* v. *Machlett,* 36 F. 2d 574, as to the problems raised by the doctrine of equivalency has been fully answered by this Court's opinion in the case of *Graver* v. *Linde* where this Court sets forth the considerations that will be determinative in applying the doctrine of equivalents. That Judge Learned Hand did not adhere to his suggested position that there should be no doctrine of equivalents, is clearly disclosed by his opinion in the case of *Musher Foundation* v. *Alba Trading Co.,* 150 F. 2d 885, where he not only recognized the doctrine and applied it rather generously but actually cited his earlier opinion in the *Claude Neon Lights* case.

The cases of *Sears Roebuck & Co.* v. *Delta Mfg. Co.,* 78 F. 2d 745, and *Apex Electrical Mfg. Co.* v. *Maytag Co.,* 122 F. 2d 182, both in the Seventh Circuit, rather than creating any conflict with the ruling of the Seventh Circuit in this case or any of the other cases cited by Petitioner, actually are in direct line with the classic authorities on the doctrine of equivalents. They hold that where the accused device does not contain all of the elements of the patentee's preferred embodiment but does perform the same functions in substantially the same manner with substantially the same means, infringement will follow.

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Petitioner does not content itself with the doctrine of these cases, but seeks to engraft a further limitation upon the doctrine of equivalents to the effect that the removal of one element—even though its function and structure are incorporated in another element of the combination—prevents the application of the doctrine. This is an attempt to engraft upon a substantial doctrine an irrational, formalistic technicality which this Court has warned against in the case of *Graver* v. *Linde*, 339 U. S. 605, 608-609.

The Fourth "Question Presented" Is Raised By a Motion to Reopen Judgment Filed in the Court of Appeals, the Record of Which Has Not Been Brought to This Court, But Which in Any Event Does Not Raise This Issue.

Petitioner states as its fourth question (Pet., p. 3):

> "4. Is evidence of the inherent operation of an old device inadmissible to prove anticipation merely because the old device is disclosed in the drawings of a patent issued by a foreign country?"

This question is based upon Petitioner's Motion to Reopen Judgment, based on allegedly newly discovered evidence, which was filed in the Court of Appeals and disposed of by a separate opinion of that Court (Pet. App., pp. 15-20).

None of the voluminous documents filed by Petitioner in the Court of Appeals upon that Motion to Reopen Judgment are presented here under the certificate of the Clerk of the Court of Appeals, according to the notice served upon Respondent by Petitioner of the documents filed. Petitioner has contented itself with two sheets of figures reconstructed from three patents to Serin, one British and two French, upon which that Motion was based (Pet. App., pp. 67-68). Petitioner has not chosen to include in its

record here the text of those patents, the reconstructed links filed in the Court of Appeals by Petitioner as alleged embodiments of the disclosures of these patents, nor any of the material filed by Respondent in that Court demonstrating the complete lack of merit in the Motion to Reopen.

The Petition would make it appear that the Court of Appeals disposed of the Motion to Reopen summarily on the ground that since the patents relied upon by Petitioner in that Court were foreign patents, some new test of anticipation placing "allegedly anticipating foreign patents * * * in a radically different category from prior American patents" (Pet., p. 13) was applied by the Court of Appeals.

Were the question of the ruling by the Court of Appeals on the Motion to Reopen reviewable here except as a question of discretion (*Toledo Scale Co.* v. *Computing Scale Co.*, 261 U. S. 399, 420-421), it could be readily pointed out that the Court of Appeals even by-passed the substantial challenge to Petitioner's diligence in presenting the Motion to Reopen, in order to consider on the merits the allegedly anticipatory patents to Serin. The Court concluded that these patents presented no more than a refinement on the Shipe patent, which the Court had fully considered in its original opinion. The extensive opinion by the Court of Appeals on the Serin patents is set forth in Petititioner's Appendix, pages 15-20.

The references to *Carson* v. *American Smelting & Refining Co.*, 4 F. 2d 463, 465 by the Court of Appeals merely announced agreement with the rule of law long recognized by the United States courts as a practical restatement of the dictates of the Patent Act. That rule is that a patent is not anticipated by any publication or patent which does not exhibit the invention in such clear and exact

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terms as to enable a person skilled in the art to practice the disclosure without the necessity of making experiments. Neither in the *Carson* case nor in this case did the Court of Appeals summarily reject the foreign patent as a reference because of its foreign origin, but in both cases the Court carefully examined the disclosure to determine whether or not there was a publication adequate to teach the invention.

Further, in this case, the Court of Appeals not only satisfied itself independently of the inadequacy of the reference, but further found that the foreign reference disclosed merely a refinement of the disclosure of the Shipe patent which had been demonstrated to be structurally and functionally nonanalogous to the patent in suit.

The ruling by the Court of Appeals was thus squarely on the substance of the disclosure of the Serin patents and did not turn upon any special rule of construction.

No conflict with other decisions in other circuits exists.

The Petition should be denied.

Respectfully submitted,

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Chicago, May 11, 1955.